REMARKS/ARGUMENTS

Claims 1-2 and 5-9 are currently pending in this application. Claims 1 and 2 are amended. Claim 1 is amended to include subject matter from page 9, line 25 to page 10, line 25 and page 18, lines 17-22 and 29-32 of the specification ("assigning at least one custom sized envelope a custom sized envelope name in client software that permits a plurality of custom sized envelopes to be created and stored"; "allowing a user to at least one of modify, add and delete a custom sized envelope name in the client software"; "accessing printer information stored in a server-based database"; "having the client software complete pre-rendering algorithms based on the envelope size selected by determining whether to virtualize"; and "printing the postal indicia on said custom sized envelope using the printer information from the server-based database to determine when it is necessary to virtualize and if so, what size paper to virtualize to.") Claim 3 is canceled herein and claim 4 was previously canceled. No new matter is added to the claims. Applicant respectfully requests reconsideration and allowance of claims 1, 2 and 5-9.

In the rejection of September 29, 2004, the Examiner rejects claims 1-9 under 35 U.S.C. 103(a) as allegedly being unpatentable over Microsoft Word 2000 in view of U.S. patent no. 5,819,240 to Kara. In support of this rejection, the Examiner states that "Microsoft Word teaches a method of printing postal indicia on a custom sized envelope comprising: determining a size of said custom sized envelope; selecting a height of said custom sized envelope; selecting a width of said custom sized

envelope; … rendering a postal indicia in accordance with the selected width and height of said customer sized envelop (see 'Preview' picture of envelope with postal indicia in 'Envelope Options' window of Figure 1 of this action); and printing the postal indicia on said customer sized envelope (see Figure 2 of this action)."

The Examiner states that Microsoft Word does not teach the postage indicia comprising machine readable data representing postage value, but states that Kara teaches printing postage on envelopes, integrating the postage printing system into a word processing system, and including machine readable data in the postage meter stamp.

The Examiner further states that it would have been obvious to one having ordinary skill in the art to include the ability to print postal indicia comprising machine readable data representing postage value, because one having ordinary skill in the art would recognize that this functionality would be advantageous for eliminating the need for stamps or other cumbersome methods of ensuring proper postage was placed on envelopes.

Applicant has carefully studied the Microsoft Word 2000 product and Kara and respectfully submits that amended independent claim 1 includes limitations neither taught nor suggested by these references, namely the features of "assigning at least one custom sized envelope a custom sized envelope name in client software that permits a plurality of custom sized envelopes to be created and stored"; "allowing a user to at least one of modify, add and delete a custom sized envelope name

in the client software"; "accessing printer information stored in a server-based database"; and "having the client software complete pre-rendering algorithms based on the envelope size selected by determining whether to virtualize and what size paper to virtualize." In the Microsoft product, the software does not involve these steps and Applicant respectfully submits that following these steps would be unobvious to one having ordinary skill in the art because Microsoft Word does not utilize printer information from the server-based database to generate custom sized envelopes and print postage indicia.

Moreover, in rejecting claim 3 directed to the naming of custom sized envelopes, the Examiner stated that "[r]egarding claim 3, the combination of Microsoft Word and Kara teaches all that is claimed as discussed in the rejection of claim 1 above. Microsoft Word also teaches assigning said customer envelope a custom name. The 'Add to Document' button in the 'Envelopes and Labels' window of Figure 1 of this action allows the user to add the customer sized envelope to the document. The document may then be named and save on the user's computer."

As noted above, claim 1 is amended to include the limitations of "assigning at least one custom sized envelope a custom sized envelope name in client software that permits a plurality of custom sized envelopes to be created and stored" and "allowing a user to at least one of modify, add and delete a custom sized envelope name in the client software".

Applicant has carefully evaluated the Microsoft Word 2000 product and respectfully disagrees with the Examiner's description of same. It is true that a user could indeed save a

document under a name, such as "c:\custom sized envelope\9.3"x4.2" that is, for example, sized to print out an envelope having the dimensions of 9.3" x 4.2". However, such a document would have to include whatever text the document was last saved with and would be associated with the base document (e.g. a business letter) and therefore could not be easily reused to print other envelopes associated with other letters or documents. Moreover, Microsoft Word 2000 lacks the ability to store multiple custom sized envelopes which relegates a user to creating a custom sized envelope each time he/she wishes to print out an envelope.

Applicant further points out that with Microsoft Word 2000, while a user is working on a document (e.g., a letter), the user can select the "Tools- Letters and Envelopes ▶ Envelopes and Labels" tab to begin to create an envelope. If the user has not selected the addressee block before invoking the envelope generating feature, the software will fill in what the software determines to be the mostly likely outgoing address. If the user has selected a return address, this also can optionally be printed. These convenient features would be lost if the user saves a custom sized envelope as a Word document. Indeed, if the user were to follow the steps the Examiner proposes, the user would need to go to the separate Word document that corresponds to the envelope and copy and paste the address information from the letter to the envelope document. If these were done, features such as barcode printing, FIM printing and the like would not be available from such an approach. It is therefore submitted that Microsoft Word would not teach or
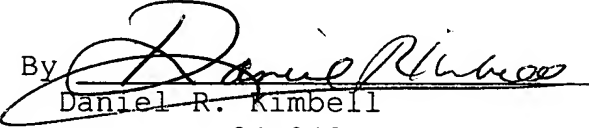
suggest to one having ordinary skill in the art the recited feature of claim 1.

Based on the foregoing, Applicant respectfully requests an early issuance of a patent with claims 1, 2 and 5-9. If there are any remaining issues that can be addressed over the telephone, the Examiner is invited to call applicants' attorney at the number listed below.

Respectfully submitted,

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